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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,662	01/09/2002	Fletcher L. Chapin	END920010017US1	8236

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ALBANY, NY 12207

EXAMINER

PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary

Applicati n N .

10/043,662

Applicant(s)

CHAPIN ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this c mmunication appears on the c ver sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 21-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kruse.

Kruse discloses the same invention including a duct including an interior sloped side (151a), that the interior sloped side creates a first opening for receiving a part and a second opening (Fig. 14), that the part exits the second opening substantially vertical (Fig. 14), a machine for detaching the part from the web (4), that the duct is coupled to the machine so that the part is received by the first opening of the duct after being detached (Fig. 3), that the machine includes a punch (4) and a die (10 and 150), that the die includes an opening through which the part passes before it is received in the duct (158), that the duct is made of metal (Fig. 14), that the interior slope is planar (151a), and that the second opening is smaller than the first opening (Fig. 14).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 6 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse in view of Bareis et al. Kruse discloses the invention including that the interior sloped side creates a first opening for receiving a part and a second opening (Fig. 14), that the part exits the second opening substantially vertical (Fig. 14) but fails to disclose that the duct includes a plurality of interior sloped sides. Bareis et al. teaches a duct with a plurality of interior sloped sides (Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kruse with a duct with a plurality of sloped sides, as taught by Bareis et al., to allow for better control of the orientation of the work piece.

5. Claims 7, 8, 21, and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse in view of Nakayama. Kruse discloses the invention including a duct including an interior sloped side (151a), that the interior sloped side creates a first opening for receiving a part and a second opening (Fig. 14), a container (152) for holding the part (S), and that the container has an open end that is coupled to the duct to receive the part from the second opening (160) but fails to disclose that the container has a convex contoured end, that the convex contoured end conforms to the curled shape of the part, and that the container accommodates a plurality of parts with a curled shape stacked upon each other. Nakayama teaches a container (27) that has a contoured end (26), that the contoured end conforms to the curled shape of the part (Fig. 7), and that the container accommodates a plurality of parts with a curled shape stacked upon each other (Fig. 7). Therefore, it would have been obvious to one of

ordinary skill in the art, at the time of the invention, to have provided Kruse with contoured container, as taught by Nakayama, to stack the parts evenly.

Kruse and Nakayama disclose the invention but fail to disclose that the contoured end of the container is convex. It would have been an obvious matter of design choice to make the different portions of the contoured end of the container of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

6. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse in view of Nakayama as applied to claims 7 and 21 above, and further in view of Amarakoon. Kruse and Nakayama disclose the invention but fail to disclose that the container is coupled to the duct with a U-shaped channel. Amarakoon teaches a container that is coupled to the duct with a U-shaped channel (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kruse in view of Nakayama with a U-shaped channel, as taught by Amarakoon, for an alternate means to connect the container to the duct.

7. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse in view of Bareis et al. as applied to claim 24 above, and further in view of Nakayama. Kruse and Bareis et al. disclose the invention including that the container has an open end that is coupled to the duct to receive the part from the second opening (160 in Kruse) but fails to disclose that the container has a convex contoured end, that the convex contoured end conforms to the curled shape of the part, and that the

container accommodates a plurality of parts with a curled shape stacked upon each other. Nakayama teaches a container (27) that has a contoured end (26), that the contoured end conforms to the curled shape of the part (Fig. 7), and that the container accommodates a plurality of parts with a curled shape stacked upon each other (Fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kruse in view of Bareis et al. with contoured container, as taught by Nakayama, to stack the parts evenly.

Kruse, Bareis et al., and Nakayama disclose the invention but fail to disclose that the contoured end of the container is convex. It would have been an obvious matter of design choice to make the different portions of the contoured end of the container of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse in view of Bareis et al. further in view of Nakayama as applied to claims 24 and 25 above, and further in view of Amarakoon. Kruse, Bareis et al., and Nakayama disclose the invention but fail to disclose that the container is coupled to the duct with a U-shaped channel. Amarakoon teaches a container that is coupled to the duct with a U-shaped channel (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kruse in view of Nakayama with a U-shaped channel, as taught by Amarakoon, for an alternate means to connect the container to the duct.

Response to Arguments

9. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vickery, Richards, Maceyka, Urschel et al., Forsberg et al., and Villines et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



JP
October 2, 2003



Allan N. Shoap
Supervisory Patent Examiner
Group 3700